REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, the specification has been amended to correct minor typographical errors, claims 1, 9, 12 and 19 have been amended, and claims 2 and 13 have been cancelled. Accordingly, Claims 1, 3-12 and 14-19 are pending in this application. The amendments to the specification and to the claims do not add any new matter to this application. Each pending claim is in condition for allowance over the cited art because one or more elements of each pending claim is not disclosed, taught, or suggested by the cited art. All issues raised in the Office Action mailed July 23, 2004 are addressed hereinafter.

REJECTION OF CLAIMS 1-12 AND 14-28 UNDER 35 U.S.C. § 102(e)

Claims 1-8 and 10-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,983,200 to Slotznick (hereinafter "Slotznick"). It is respectfully submitted that Claims 1, 3-8, 10-12 and 14-18 are patentable over Slotznick for at least the reasons provided hereinafter.

CLAIMS 1 AND 12

Claim 1 has been amended to include the limitations of claim 2. Claim 12 is similar to claim 1, and likewise has been amended to include the limitations of claim 13.

As is described in the specification at Page 13, line 1 – Page 14, line 5, and shown in Fig. 3B, in one embodiment, a wireless device user can request a hard copy of an electronic document or of a web page. The requested electronic document or the contents of the requested web page are downloaded to the web server application 346 of the printer interface component 334 and

automatically sent to a print driver 350 to generate a print ready file based on the downloaded electronic file or web page contents. In this embodiment, the claimed printer interface component can be used by wireless device users to obtain hard copies of electronic documents even though the wireless device is not configured with a printer, and cannot generate a print ready file.

Accordingly, along with other limitations, representative amended Claim 1 recites:

"a printer interface component that includes a web server application configured to receive non-print ready electronic document information over said wireless connection, wherein said printer interface component is configured to generate a print ready file based on said non-print ready electronic document information received over said wireless connection, and to communicate said generated print ready file to a printing device for generating a hard copy of said one or more electronic documents"

It is respectfully submitted that this limitation is not taught or suggested by *Slotznick*. In the rejection of claim 2, the Office Action asserts that *Slotznick* discloses a web server application as required by amended claim 1 at Col. 16, lines 6-18 and Col. 21, lines 5-26. These sections of *Slotznick* only mention that the kiosk can be connected to the Internet and that data can be transmitted over the Internet. Nowhere in these cited sections, or anywhere in *Slotznick*, is a <u>web server</u> mentioned or suggested. As those skilled in the art will appreciate, web server applications interact with and provide services to web clients, such as browsers, and may send and/or receive HTML files or pages. *Slotznick* does not teach or suggest a printer interface component that includes a web server.

Furthermore, representative claim 1 further requires that the web server application is configured to receive non-print ready electronic document information, and the printer interface component is configured to generate a print ready file based on the received non-print ready electronic document information. The Office Action asserts that "credit card payment

Examiner: Thierry L. Pham, GAU 2624

Docket No. 49986-0503

information transmits via a wireless network" disclosed by Fig. 3 and Col. 16, lines 18-30 of *Slotznick* teach this limitation. However, *Slotznick* only teaches that credit card information can be transmitted over a network; *Slotznick* does not teach or suggest generating a print ready file <u>based on</u> the credit card information. Credit card information is used to pay for a product produced by the kiosk, it is not used as the basis for the content of a hard copy document.

Claims 1 and 12 of the present invention recite generating a print ready file based on non-print ready electronic document information received by a web server application, and *Slotznicki* does not teach or suggest this feature.

It is therefore respectfully submitted that the limitation of "a printer interface component that includes a web server application configured to receive non-print ready electronic document information over said wireless connection, wherein said printer interface component is configured to generate a print ready file based on said non-print ready electronic document information received over said wireless connection, and to communicate said generated print ready file to a printing device for generating a hard copy of said one or more electronic documents" required by claims 1 and 12 is not in any way taught or suggested by *Slotznick*, and claims 1 and 12 are therefore patentable over *Slotznick*.

CLAIMS 3-8 AND 14-18

Claims 3-8 and 14-18 all depend from claims 1 and 12, respectively, and include the limitations of these independent claims by virtue of their dependence. Therefore, claims 3-8 and 14-18 are patentable over *Slotznick* for at least the reasons set forth herein with respect to claims 1 and 12. Furthermore, these dependent claims recite one or more additional limitations that independently render them patentable over the cited art. In view of the patentability of the

Examiner: Thierry L. Pham, GAU 2624

Docket No. 49986-0503

independent claims, these dependent claims are not further traversed at this time in order to expedite prosecution.

CLAIM 10

Claim 10 requires the limitation of "wherein the wireless communication component includes a front side and a back side, and wherein the receiving component is shielded to limit reception of said electronic document information from only those devices that are located substantially in front of the wireless communication component." As set forth in the specification at Page 14, line 8 – Page 15, line 10, in one embodiment, the interface box is shielded so as to limit the direction of the RF signal that is being transmitted from the wireless device. By limiting the signal to an area directly in front of the interface box, an inherent security mechanism is provided that reduces the chance that the signal is received by an unauthorized user, as a wireless device must be positioned substantially in front of the interface box to communicate with the printing interface apparatus.

The Office Action asserts that the "back of the stand-alone kiosk is shielded" and cites Fig. 1 of *Slotznick* as teaching this feature. While the kiosk shown in Fig. 1 does have a front side and a back side, there is no shield shown anywhere on the kiosk. Furthermore, claim 10 features that reception is limited to those wireless devices that are located substantially in <u>front</u> of the wireless communication component. Even if Fig. 1 disclosed any type of shield, which it does not, the Office Action asserts that the <u>back</u> of the stand-alone kiosk is shielded. Claim 10 states that electronic document information can be received only those devices that are located substantially in <u>front</u> of the wireless communication component.

It is therefore respectfully submitted that this limitation of claim 10 is not in any way taught or suggested by *Slotznick*, and claim 10 is therefore patentable over cited art.

CLAIM 11

The printing interface apparatus of claim 11 requires:

- a wireless communication component that is configured to receive an electronic document file from a wireless device over a wireless connection;
- a server component that is configured to dynamically generate an electronic document for display on the wireless device, wherein the electronic document is based on the received electronic document file and includes a print request selector that allows a user to request a hard copy of said electronic document file;
- a printer interface component that is configured to communicate data, based on said electronic document file, to a printing device for generating a hard copy of said electronic document file; and
- a payment component that is configured to control the printing of documents by requiring a monetary payment prior to generating said hard copy of said electronic document file.

The Office Action asserts that the rationale for the rejection of claim 1 can be applied to claim 11. However, claim 11 recites different limitations than claim 1. In particular, claim 11 includes a server component configured to dynamically generate an electronic document for display on a wireless device, wherein the generated electronic document is based on a received electronic document file and includes a print request selector that allows a user to request a hard copy of the electronic document file. *Slotznick* does not teach or suggest generating any type of electronic document to display on a wireless device, much less a document that includes a print request selector.

It is therefore respectfully submitted that this limitation of claim 11 is not in any way taught or suggested by *Slotznick*, and claim 11 is therefore patentable over cited art.

In view of the foregoing, it is respectfully submitted that Claims 1, 3-8, 10-11 and 13-18 are patentable over *Slotznick*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1, 3-8, 10-12 and 14-18 under 35 U.S.C. § 102(b) as being anticipated by *Slotznick* is respectfully requested.

REJECTION OF CLAIMS 9 AND 19 UNDER 35 U.S.C. § 103(a)

Claims 9 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slotznick* in view of U.S. Patent No. 6,452,692 to Yacoub (hereinafter "*Yacoub*"). It is respectfully submitted that Claims 9 and 19 are patentable over *Slotznick* and *Yacoub*, alone or in combination, for at least the reasons provided hereinafter.

Claims 9 and 19, dependent on claims 11 and 12 respectively, include all the limitations of these independent claims by virtue of their dependence. As previously set forth herein, Claims 1 and 12 include one or more limitations that are not taught or suggested by *Slotznick*. It is also respectfully submitted that these limitations are also not taught or suggested by *Yaucob*. For example, as discussed above, Claims 1 and 12 require a "printer interface component that includes a web server application." *Yacoub* describes a networked printer solution that allows a user to select job-relevant preferences without having to select a particular printer. There is no description in *Yacoub* of a printer interface that includes a web server application as required by claims 1 and 12.

Claims 1 and 12, and likewise claims 9 and 19 dependent thereon, include one or more limitations that are not taught or suggested by *Slotznick* and *Yacoub*, alone or in combination, and are therefore patentable over the cited art. Accordingly, reconsideration and withdrawal of the rejection of Claims 9 and 19 under 35 U.S.C. § 103(a) is respectfully requested

AMENDMENT

Ser. No. 09/747,650 filed December 22, 2000, Shingo Yamaguchi

Examiner: Thierry L. Pham, GAU 2624

Docket No. 49986-0503

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date:

....

Lesley Coulson Boveri

Reg. No. 46,642

1600 Willow Street San Jose, CA 95125 (408) 414-1204

Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

on

October 29, 2004

hv